

REMARKS

Claims 18-20, 30-44 and 51-56 are pending. Claims 1-17, 21-29 and 45-50 have been withdrawn. Claims 38 and 52 have been canceled. Claims 18, 30, 34, 51 and 55 have been amended.

REJECTIONS UNDER 35 U.S.C. §102(b)

Claims 18-20, 30-36 and 42 stand rejected under 35 U.S.C. Sec. 102(b) as being anticipated by U.S. Patent No. 5,876,373 to Giba et al. (hereinafter "Giba"). Claims 34, 37, 39-41, and 43-44 stand rejected under 35 U.S.C. Sec. 102(b) as being anticipated by U.S. Patent No. 6,478,793 to Cosman et al. (hereinafter "Cosman"). Claims 51-53 stand rejected under 35 U.S.C. Sec. 102(b) as being anticipated by U.S. Patent No. 6,120,520 to Saadat et al. (hereinafter "Saadat"). Claims 55-56 stand rejected under 35 U.S.C. Sec. 102(b) as being anticipated by U.S. Patent No. 6,520,927 to Unsworth et al. (hereinafter "Unsworth"). It is respectfully submitted that the amendments submitted herewith overcome the Examiner's rejections.

Applicants state that the structure of the devices disclosed in Giba, Cosman, Saadat and Unsworth are fundamentally different than that of the present disclosure as none of them apply mechanical energy to the medical device via an actuator that enables tissue penetration in either an axial or rotational direction. Giba discloses a spring that works solely in an axial direction; Saadat also discloses means that only operate in an axial direction; and likewise Unsworth discloses a device with a linear screw drive. Cosman discloses a device used to penetrate and treat bone as opposed to initial penetration of skin. The device of Cosman is also unclear on whether the same driver (124 in Fig. 2 and 180 in Fig. 3) that rotates the rigid shaft (80 in Fig. 2 or 230, 160, 184 or 203 in Fig. 3) is able to be used to create movement in an axial direction as well. It would appear that shear pushing by the operator is

the method by which all of the devices disclosed in Cosman are advanced throughout the body. It is well settled that in order for a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in prior art. The disclosure requirement under 35 U.S.C. 102 presupposes knowledge of one skilled in art of claimed invention, but such presumed knowledge does not grant license to read into prior art reference teachings that are not there. *See Motorola Inc. v. Interdigital Technology Corp.* 43 U.S.P.Q.2d 1481 (Fed. Cir. 1997). The devices of the present application are therefore clearly distinguishable from the prior art of record and reconsideration is respectfully requested based on the present claims.

REJECTIONS UNDER 35 U.S.C. §103

Claim 54 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,702,790 to Ross et al. (hereinafter “Ross”) in view of Sadaat. Because the Sadaat reference has been distinguished and Ross does not disclose a needle that is energized with mechanical energy, Applicants request that this rejection be withdrawn in view of the present remarks and amendments.

Based on the above amendments and remarks, Applicants submit that the application is now in condition for allowance. If any further issues are yet to be resolved to advance the prosecution of this patent application to issue, the Examiner is asked to contact the undersigned counsel.

Reconsideration and allowance are respectfully requested.

Respectfully submitted,

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David Schramm
Reg. No. 41,295
Medrad, Inc.
One Medrad Drive
Indianola, PA 15051
Telephone: (412) 767-2400 x4302